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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

037033-0314075

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Application Number

08/983,394

Filed

August 5, 2002

First Named Inventor

FALLS ET AL.

Art Unit

3627

Examiner

Jasmin, Lynda

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 32694☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

James G. Gatto

Typed or printed name

703.770.7754

Telephone number

September 29, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Attorney Docket: 037054-0314075
Client Reference: 22249-5



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of: FALLS ET AL. Confirmation Number: 1379

Application No.: 08/983,394

Group Art Unit: 3627

Filed: August 5, 2002

Examiner: Lynda Jasmin

Title: ELECTRONIC PRODUCT INFORMATION DISPLAY SYSTEM

Remarks Supporting Request for Pre-Appeal Brief Conference

Summary

The subject application has been fully examined and prosecuted to a Final Rejection, which indicates that the application contains claims that would be allowable but for formal issues. The Applicants filed an After-Final Amendment to cancel the single claim rejected in view of prior art and to amend the claims to overcome all of the formal rejections in a way consistent with that discussed with Examiner Fischer during a May 3, 2006 telephone interview. A second examiner, Examiner Jasmin, took over prosecution of the subject application some time after the May 3, 2006 telephone conference and now fails to give full faith and credit to Examiner Fischer's examination. Examiner Jasmin indicates that she will issue a new Office Action but she has not done so and she has provided no new grounds of rejection. Further, the application has been left by the Patent Office to go abandoned but for the Notice of Appeal submitted herewith. Thus, the application remains under the Final Rejection, which clearly has been overcome by the After-Final Amendment, but the Patent Office refuses to enter or even formally respond to the After-Final Amendment. Full faith and credit should be given to the currently outstanding Final Rejection and the After-Final Amendment should be entered to place the application in condition for allowance.

The March 29, 2006 Final Rejection

The March 29, 2006 Final Office Action was issued by Examiner Fischer contained three rejections and an indication of allowable subject matter. Rejections were established under (i) 35 USC § 101, (ii) 35 USC §112, 2nd paragraph, and (iii) 35 USC §103(a). Also, claims 72-91 and 93-132 were indicated as being allowable over the prior art of record

assuming the rejections under 35 USC § 101 and 35 USC §112, 2nd paragraph were overcome.

The May 3, 2006 Telephone Interview with Examiner

Since, in response to the Final Rejection, Applicants had decided to place the application in condition for allowance, a May 3, 2006 telephone interview was conducted between Examiner Fischer and Applicants' representative to discuss the outstanding formal rejections and to discuss acceptable language to overcome the formal rejections and place the application in condition for allowance.

The July 31, 2006 Amendment After Final Rejection

In response to the Final Office Action and after the May 3, 2006 telephone interview with Examiner Fischer, the Applicants filed an Amendment After Final Rejection on July 31, 2006 in order to accept the allowed subject matter in the Final Rejection by amending the claims to overcome the formal rejections under 35 USC § 101 and § 112, and by cancelling claim 92, which was the only claim rejected under 35 USC §103.

a. Rejections Under 35 USC §101

The rejection under 35 USC §101 was based on the premise that claims 117 and 127-131 were directed to non-statutory subject matter. In response, consistent with the Examiner's comments during the telephone interview, the preambles of independent claims 117 and 127 were amended to clearly recite statutory subject matter by including that the claims are directed to a "computer readable medium encoded with a data structure and a computer program, wherein the computer program uses the data structure for identifying and organizing products displayed by a business establishment." Such claim language was discussed and generally approved by Examiner Fischer during the May 3, 2006 telephone interview and is clearly statutory subject matter, especially in view of the guidelines set forth in MPEP 2106, particularly in MPEP 2106 (IV)(B)(1).

b. Rejections Under 35 USC §112, 2nd paragraph

The claims rejected under 35 USC §112, 2nd paragraph were amended to overcome the rejections in light of Examiner Fischer's comments in the Final Rejection and further in view of Examiner Fischer's comments during the May 3, 2006 telephone interview.

Claims 72 and 77 were rejected as being unclear as to whether the claims were directed to a printed label, or the combination of a printed label and a shelf. During the May 3, 2006 interview, Examiner Fischer indicated that the claims were allowed based upon the interpretation that the claims were directed to the combination of the label and the shelf. Accordingly, claims 72 and 77 are amended to recite the combination of the label and shelf.

Claims 79 and 99 were rejected since the word "planogram" was deemed "unclear." However, the After-Final Amendment makes clear that the term is established in the art and provides specific U.S. patents using the word "planogram" to further evidence the term as being a term of art consistent with discussions with Examiner Fischer on May 3, 2006. Accordingly, no amendments to claims containing the word "planogram" were made.

Claim 99 were rejected since the term "a graphic edge" was deemed "unclear." In response, the claim was amended to recite a "shelf edge," which was selected after discussions with Examiner Fischer on May 3, 2006.

Claim 125 was rejected for indefiniteness related to the terms "product" and "at least one or more products." In response, the claim was amended to clarify that which is being claimed as the "product," consistent with the discussions with Examiner Fischer on May 3, 2006.

Claim 127 was rejected since it was deemed unclear as to whether the claim was directed to a database or a database in combination with a shelf. In response, the claim has been amended to clarify that the claim is directed to a computer readable medium, consistent with the discussions with Examiner Fischer on May 3, 2006.

c. Rejection Under 35 USC §103(a)

The rejection of claim 92 under 35 USC §103(a) was rendered moot in view of the cancellation of claim 92.

Accordingly, the July 31, 2006 After-Final Amendment clearly places the application in condition for allowance.

Patent Office's Response to After-Final Amendment

Even though the After-Final Amendment was filed on July 31, 2006, to date no Advisory Action has been mailed in response thereto. Only after Applicants' representative, on their own initiative, contacted Examiner Fischer on September 11, 2006, was Applicants' representative notified that the application had been transferred to another examiner. Applicants' representative was not able to determine the identity of the new examiner and speak to the new examiner of record, Examiner Jasmin, until speaking to her by telephone on September 18, 2006. Applicants' representative then had numerous telephone conversations with Examiner Jasmin on September 21, 2006 and on September 26, 2006, in which Examiner Jasmin's position changed from agreeing that all of the claims were allowable in view of the After-Final Amendment except for claims 125-131, to eventually stating that she would not agree to allow any of the pending claims. Examiner Jasmin then issued a September 26, 2006 Interview Summary stating that the Final Rejection "will be withdrawn."

Since the September 26, 2006 Interview Summary did not actually withdraw the Final Rejection¹ and since no new Office Action has been issued, the Patent Office effectively offered no response to the July 31, 2006 After-Final Amendment. Also, since it is not evident that Examiner Jasmin is required to take any further action on the application, the Applicants have been left with no choice but to file the Notice of Appeal submitted herewith.

Most notably, however, Examiner Jasmin failed to provide full faith and credit to Examiner Fischer's examination and did not comply with MPEP 706.04, which states that:

Full faith and credit should be given to the search and action of a previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general, an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner, or make a new search in the mere hope of finding something. *>Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 126 F. Supp. 2d 69, 139, 57 USPQ2d 1449, 1499-50 (D. Mass. 2001).

Meanwhile, Applicants are faced once again with the possibility of re-arguing the same references considered by Examiner Fischer because Examiner Jasmin is improperly attempting to take an entirely new approach to reorient the point of view of Examiner Fischer and make a new search in the mere hope of finding something new. Had Examiner Jasmin

¹ It is not evident that such correspondence could withdraw the Final Rejection

provided full faith and credit to Examiner Fischer's examination, the After-Final Amendment would be entered since it clearly overcomes the outstanding rejections and Applicants would not be faced with the burden of re-arguing the same prior art references.

Conclusion

The application remains rejected under the March 29, 2006 Final Rejection, which clearly has been overcome by the July 31, 2006 After-Final Amendment. Full faith and credit should be given to the currently outstanding Final Rejection and the After-Final Amendment should be entered to place the application in condition for allowance.

Respectfully submitted,

PILLSBURY WINTHROP SHAW PITTMAN LLP



James G. Gatto
Reg. No. 32694
Tel. No. 703 770.7754
Fax No. 703-770-7901

Date: September 29, 2006
P.O. Box 10500
McLean, VA 22102
(703) 770-7900



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